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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/893,680	06/29/2001	Hiroyuki Ishiwata	208671US	9420

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EXAMINER

COLEMAN, BRENDA LIBBY

ART UNIT	PAPER NUMBER
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1624

DATE MAILED: 09/03/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/893,680

Applicant(s)

ISHIWATA et al.

Examiner

Brenda Coleman

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1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jun 16, 2003
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1, 2, 4-6, 9, and 13 is/are allowed.
- 6) ☒ Claim(s) 3, 7, 8, 10-12, and 14-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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DETAILED ACTION

Claims 1-20 are pending in the application.

This action is in response to applicants' amendment filed June 16, 2003. Claims 1, 3, 4 and 9-14 have been amended and claims 15-20 are newly added.

Response to Amendment

Applicant's amendments filed June 16, 2003 have been fully considered with the following effect:

1. With regards to the rejection as being drawn to an improper Markush group of the last office action, the applicant's stated that they have "amended the claims to remove the non-elected subject matter", however, this is not so with respect to the species of claim 8. The species spanning line 24 on page 98 through line 1 on page 99 and lines 9-10 on page 99 are directed to non-elected subject matter.

Claim 8 is rejected as being drawn to an improper Markush grouping. For reasons of record and stated above.

2. The applicant's amendments and arguments are sufficient to overcome the objection to the specification under 35 USC § 132 in the last office action, which is hereby **withdrawn**.

3. The applicant's amendments and arguments are sufficient to overcome the 35 USC § 112, first paragraph rejection of claims 4 and 5, labeled paragraph 5 in the last office action, which is hereby **withdrawn**.

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4. The applicant's amendments and arguments are sufficient to overcome the 35 USC § 112, first paragraph rejection of claims 9-14, labeled paragraph 6 in the last office action, which is hereby **withdrawn**.

5. The applicant's amendments and arguments are sufficient to overcome the 35 U.S.C. § 112, second paragraph rejections labeled paragraph 7 of the last office action, which are hereby **withdrawn**.

6. The applicant's arguments are sufficient to overcome the provisional obviousness-type double patenting rejection in the last office action, which is hereby **withdrawn**.

In view of the amendment dated June 16, 2003, the following new grounds of rejections apply:

Specification

The disclosure is objected to because of the following informalities:

- a) the amendment to the nomenclature of Example 57 on page 90 does not correspond to the structure of Example 57, i.e. (3,5-dimethoxy**phenyl**)-4-(2,2,2-trifluoroethoxy)phenyl.
- b) the amendment to the nomenclature of Example 58 on page 93 does not correspond to the structure of Example 58, i.e. (3,5-dimethoxy**phenyl**).

Appropriate correction is required.

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Claim Rejections - 35 U.S.C. § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 10-12 and 14-20 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The amendment of claims 10-12 and 14 and the addition of claims 15-20, includes an amendment to the preamble which are not described in the specification, i.e. arresting, alleviating or reducing.

Applicant is required to cancel the new matter in the reply to this Office action.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 3, 7 and 8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The following reasons apply:

- a) Claim 3 is vague and indefinite in that it is not further limiting of the claim in which it depends.

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- b) Claim 7 recites the limitation "trifluoroethoxy, methoxyethoxy and hydroxyethoxy" in the definition of the substituents on the aromatic hydrocarbon. There is insufficient antecedent basis for this limitation in the claim.
- c) Claim 8 recites the limitation "1,4-bis[2-(3,4,5-trimethoxyphenyl)-5-pyridyl]hexahydro-1,4-diazepine dimethanesulfonate" in the list of species. There is insufficient antecedent basis for this limitation in the claim. See the third species in claim 8.
- d) Claim 8 recites the limitation "2-dimethylaminomethyl-1,4-bis[2-(3,4,5-trimethoxyphenyl)-5-pyridyl]piperazine trihydrochloride" in the list of species. There is insufficient antecedent basis for this limitation in the claim. See lines 9-10 on page 99 in claim 8.

Allowable Subject Matter

9. Claims 1, 2, 4-6, 9 and 13 are allowed. None of the prior art of record nor a search in the pertinent art area teaches the compounds or compositions of the bis(2-aryl-5-pyridyl) compounds as claimed herein.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brenda Coleman whose telephone number is (703) 305-1880. The examiner can normally be reached on Mondays from 8:30 AM to 5:00 PM, on Tuesdays from 8:00 AM to 4:30 PM, on Wednesday thru Friday from 9:00 AM to 5:30 PM.

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The fax phone number for this Group is (703) 308-4734 for "unofficial" purposes and the actual number for **OFFICIAL** business is **308-4556**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.

A handwritten signature in black ink that reads "Brenda Coleman". The signature is fluid and cursive, with a long horizontal stroke at the end.

Brenda Coleman
Primary Examiner AU 1624
August 28, 2003